

REMARKS

1. The Amendments and the Support Therefor

Ten claims (1-10) have been canceled, eleven new claims (19-29) have been added, and claims 11-13 and 16 have been amended to leave claims 11-29 in the application. No new matter has been added by the amendments or new claims, wherein:

- *Independent claims 11, 19, and 25* find support in (for example) FIG. 2, wherein bladder 3 is shown between inner layer 5 and outer layer 6, and is joined to outer layer 6 but not inner layer 5 (and with bladder 3 defining an inflatable area, with the adjacent areas of layers 5 and 6 being noninflatable, and being shown forming side flaps about the bladder 3 in FIG. 1, with the flaps having fasteners 2).
- *Claim 12* finds support at (for example) FIG. 2, showing the bladder between the inner and outer sheets and spaced from any joined areas between the inner and outer sheets.
- *Claims 13 and 16* find support at (for example) FIG. 2, as described above with respect to claim 11.
- *Claims 20, 21, 27, and 28* find support at (for example) page 3 line 32-page 4 line 7 of the application, which note that the inner layer 5 of FIG. 2 bears embedded conductive heating elements, preferably about its entire area.
- *Claims 22 and 23* find support in (for example) FIG. 1, showing flaps with fasteners 2.
- *Claims 24 and 29* find support in (for example) original claim 7.

Further comments regarding the new claims are set out below at Section 8.

2. Section 3 of the Office Action: Objections to the Drawings

Kindly reconsider and withdraw these rejections because all matter recited in the claims is shown in the drawings, in accordance with 37 CFR §1.83(a):

- The "noninflatable portion" in original claim 10 (and now in claim 25, for example) is shown in FIG. 1 adjacent bladder 3 (e.g., at the area below reference numeral 6), as well as in FIG. 2 at the areas of sheets 5 / 6 away from bladder 3;

- The "heating elements on or within the inner sheet" of claim 14 are shown in FIG. 2, which depict the entirety of the inner sheet being made of conductive material 5.

Thus, no new drawings should be required.

3. Sections 4-6 of the Office Action: Rejection of Claims 10 and 15 under 35 USC §112(1)

Claim 10 is canceled, and thus its rejection is moot.

Regarding claim 15, this matter is enabled by (for example) FIG. 2 and page 3 line 32-page 4 line 7:

The garment 1 also includes an inner layer of thermally transmissive material 5 to apply warming to the tissues (typically between 32 and 46 degree centigrade) by passing an electrical current through the material 5. Possible materials include conductive polymers, carbon fibres, wire elements and foils. In another embodiment the inner layer 5 can be a material 5 housing electrical heating elements suitably insulated and extending the full area of the garment to provide heat to the whole circumference of the limb. The inner 5 and outer layers 6 of the garment are joined together at their peripheries enclosing the bladder 3 in between the layers.

4. Sections 7-8 of the Office Action: Rejection of Claims 1-10 under 35 USC §112(2)

These claims have been canceled, thereby mooting their rejections.

5. Sections 9-10 of the Office Action: Rejection of Claims 1, 3-4, and 8-10 under 35 USC §102 in view of U.S. Patent US 2002/0068886 to Lin

These claims have been canceled, thereby mooting their rejections.

6. Sections 11-12 of the Office Action: Rejection of Claims 2 and 6 under 35 USC §103 in view of U.S. Patent US 2002/0068886 to Lin

These claims have been canceled, thereby mooting their rejections.

7. Section 13 of the Office Action: Rejection of Claims 5, 7, and 11-18 under 35 USC §103 in view of U.S. Patent US 2002/0068886 to Lin and US 2003/0191420 to Kuiper et al.

Claims 5 and 7 have been canceled, thereby mooted their rejections.

Regarding claim 11 (as amended), *Lin* no longer seems relevant, since its alleged inner sheet 22 and outer sheet 11 don't have adjacent facing surfaces with joined areas, and with an inflatable bladder being situated therebetween on the outer sheet, and with its interior spaced away from the inner sheet. As for *Kuiper* (and US Patent 6,007,559 to *Arkans*), these show wearable compression devices wherein inflatable bladders are situated directly between inner and outer sheets: each bladder is bounded/formed by both the inner sheet and the outer sheet, such that the facing surface of the inner sheet – i.e., the surface adjacent the outer sheet – is directly adjacent the interior of the bladder. If the obviousness analysis mandated by MPEP 2142 is followed:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

We submit that if this process is followed, with the claimed invention being placed out of mind and the prior art being objectively considered from the standpoint of an ordinary artisan, it cannot fairly be said that the ordinary artisan would contemplate or consider the claimed invention: there is no apparent reason why an artisan would contemplate joining inner and outer sheets wherein the bladder is joined to / formed by the outer sheet, but is not at the same time bounded by the inner sheet. Stated simply, if an ordinary artisan wanted to place a bladder between inner and outer sheets (as shown, for example, in FIG. 2 of the application), why would the artisan not simply form the bladder from the inner and outer sheets? There is no obvious reason for the claimed arrangement.

Regarding *claim 12*, this arrangement is also unobvious. The relevant art of record, such as *Kuiper* and *Arkans*, forms the bladder directly between the inner and outer sheets (as discussed above), with the inner and outer sheets being joined to define the boundaries of the bladder. Again, there is no apparent reason why an ordinary artisan would consider the claimed arrangement.

Claims 13 and 16 are submitted to be allowable for largely the same reasons as claim 11: there is no apparent reason why an ordinary artisan would not simply affix the bladder to the inner sheet, as by forming the bladder directly between the inner and outer sheets.

Claims 14, 15, 17, and 18 are allowable for at least the same reasons as their parent claim 11.

8. New Claims 19-29

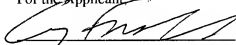
New *Independent claims 19 and 25* are submitted to be allowable for much the same reasons as claim 11: in view of the art of record and the ordinary knowledge in the art, there's no apparent reason why an ordinary artisan would consider joined inner and outer sheets with a bladder therebetween, with the bladder being joined to the outer sheet but not the inner sheet.

New dependent *claims 20-24 and 26-29* are submitted to be allowable for at least the same reasons as their patent claims.

9. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant



Craig A. Fieschko, Reg. No. 39,668
CUSTOMER NO. 25005
DEWITT ROSS & STEVENS S.C.
2 E. Mifflin St., Suite 600
Madison, WI 53703-2865
Telephone: (608) 395-6722
Facsimile: (608) 252-9243
cf@dewittross.com